

REMARKS

The present amendment is submitted as a response to a final office action issued February 18, 2009. The application consists of claims 1-13 and 16-29, of which claims 1 and 13 are currently amended.

Finality of office action

Applicants respectfully request reconsideration of the finality of the office action and its withdrawal. It is submitted that the finality of the office action is premature, at least for the following reason:

Applicants quote from MPEP 703.07(a):

"A second or any subsequent action on the merits in any application or patent involved in reexamination proceedings should not be made final if it includes a rejection, on prior art not of record, of any claim amended to include limitations which should reasonably have been expected to be claimed."

New prior art was cited by the Examiner against claims amended to include limitations which should not only have been anticipated by the Examiner, but which actually were anticipated by the Examiner. In the rejection in the prior action the Examiner rejected claims 1-13 and 16-29 under 35 U. S. C. §112 as based on a disclosure which is not enabling. The Examiner requested that "the one or more of the low mass of the wire, pulsed heating of the wire, heating the wire only when motion is detected and/or removal of the wire from skin contact when motion is not detected" be added to the claims.(see paragraph 5 of the rejection issued August 18, 2008) In their response filed on November 18, 2008, applicants have amended the claims by adding the following clause to independent claims 1 and 13 " wherein burning of the skin surface is prevented due to one or more of low mass of the wire, pulsed heating of the wire, heating the wire only when motion is detected and removal of the wire from skin contact when motion is not detected." This is the only amendment that was made to the claims in the response of November 18, 2008.

That this amendment was expected by the Examiner is clear from his request to do so.

The new art cited by the examiner was clearly made for another reason, and not because of applicants' amendment. Accordingly, applicants respectfully request traverse of the finality of the office action.

Information Disclosure Statement

The Examiner said that the IDS submitted on December 31, 2008 contains Foreign Office Actions in which foreign prior art is cited. The Examiner indicates that while the Foreign Office Actions were supplied by applicants and considered by the Examiner, a copy of the foreign prior art was not attached and therefore not considered by the Examiner. Applicants submit that the

foreign art was cited and submitted by applicants in previous filed Information Disclosure Statements and should have been considered by the Examiner.

Applicants are filing concurrently herewith an additional Information Disclosure Statement. Since the finality of the office action is contested, applicants are not filing a Request for Continued Examination with the IDS.

Claim rejections USC 103

Claims 1-13 and 16-29 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Solvinto (FR 2532878) in view of Warden et al. (US 7,048,746).

According to the Examiner, Solvinto discloses all of the claimed elements except for burning of the skin being prevented by one or more of low mass of the wire, pulsed heating of the wire, heating the wire only when motion is detected and removal of the wire from skin contact when motion is not detected. However, the Examiner asserts that this is taught by Warden.

Applicants respectfully disagree and submit that the Examiner has not provided a *prima facie* case of obviousness since Solvinto lacks additional limitations in the claims, as described below. In addition, applicants submit that the Examiner did not show how a combination of the references would result in the claimed invention. Even if one would combine the references, and applicant submits that one wouldn't, the combination would still lack limitations in the claims.

Claims 1 and 13 are the only pending independent claims. Claim 1 recites "an elongated heated wire suitable for heating hair growing from a skin surface; and at least one blade, placed at one side of the elongated heated wire, the at least one blade being situated and ***configured to cut the hair which has been heated by the heated wire***". Similarly, claim 13 recites "heating a portion of a hair attached to the skin of a person to a temperature above 50°C by contacting the portion with an elongate wire heated above 50°C; and ***cutting the hair at the heated portion with a blade***." (emphasis added). Applicants submit that this feature is not taught nor suggested by Solvinto.

Solvinto teaches a hair cutting apparatus which is in the form of a pair of scissors. One of the branches serves as a rest while the other serves as a support for a metal wire capable of being heated and cut the hair. The metal wire, heated to a temperature of 700 - 1000° C, cuts the hair by heating it. Thus, Solvinto does not have a blade configured to cut the hair which has been heated by the wire, simply because the heated wire already cuts the hair.

The Examiner indicates in paragraph 11 of his rejection that Solvinto explicitly teaches the blades cutting the hair and the heat providing an advantageous care of the cut hair by a singeing

effect as shown on pages 2-3 of the translation. Applicants have reviewed the translation and reiterate that the wire and blade are one and the same element in Solvinto. This is admitted by Solvinto itself who consistently uses the terms wire and blade for the same element. As evidence thereof, applicants quote for example from the first paragraph on page 5 of the translation "constant tension of the wire or the blade..." or the third paragraph on the same page "the metal wire or blade is mounted..." Thus, Solvinto specifically admits that the wire is the blade. Accordingly, Solvinto cannot teach cutting the heated hair with a blade since the heating and cutting is performed by the same element.

Furthermore, applicants have amended the claims to make explicit what was already implicit, namely that "the wire is positioned such that it may touch the skin during operation". This feature is not shown by any of the cited references.

In Solvinto, the wire (or blade) does not come in contact with the skin since it is used in a scissor. Warden also fails to teach a heated wire positioned such that it may touch the skin during operation. The heated element in Warden is shown as reference 15. As shown in Fig. 4 for example, heated element does not contact the skin, rather the tapered distal region 11 of piece 7 is what touches the skin and lifts the suture. Warden specifically states, in the description on col. 5, lines 4-18 that the skin is prevented from being burned since only end 7 touches the skin and end 7 has a relatively large thermal mass.

Thus, both Solvinto and Warden fail to teach a wire positioned such that it may touch the skin during operation. A combination of these references would fail to teach all of the claimed features.

It is further submitted that a person of ordinary skill in the art would not add the pulsed wire of Warden to Solvinto's device. Since the wire does not touch the skin in Solvinto, there is no danger of the skin being burned. Accordingly, Solvinto cannot prevent burning of the skin by any means simply because one cannot prevent something that cannot happen. Thus, even if one would combine Solvinto and Warden as suggested by the Examiner, the combination would result in a device where the preventing features are not used. A person of ordinary skill in the art would not add unuseful features to Solvinto's device and would certainly have no motivation to do so.

Accordingly, it is submitted that claims 1-13 and 16-29 are patentable over Solvinto in view of Warden.

Claims 1, 5-13 and 16-25 stand rejected under 35 USC 103(a) as being unpatentable over Iderosa (US 5,065,515) in view of Solvinto, Ringler (US 2002/0151881) and Warden.

The Examiner states that Iderosa teaches all of the claimed features except for the wire being heated to a temperature of at least 50°C, a temperature higher than 100°C, a temperature higher than 150°C, a temperature higher than 250°C, a temperature higher than 350°C, a temperature higher than 500°C or a temperature higher than 700°C and burning of the skin being prevented by one or more of low mass of the wire, pulsed heating of the wire, heating the wire only when motion is detected and removal of the wire from skin contact when motion is not detected. According to the Examiner, these features are obvious from Solvinto, Ringler and Warden. Solvinto teaches the use of high temperatures and Warden teaches pulsing of the wire.

Applicants respectfully disagree with the Examiner and submit that the Examiner failed to show a prima facie case of obviousness since the Examiner did not show how the combination would result in the claimed invention. While the Examiner shows reference that teach high temperatures, the Examiner did not show any reference where a heated wire that may touch the skin is heated to the claimed temperatures. Similarly, the Examiner did not show the claimed preventing features applied to a wire that may touch the skin.

Claim 1 and 13, the only independent claims in the application, are amended to make explicit what was already implicit in the claims, namely that "the wire is positioned such that it may touch the skin during operation".

The only reference that can possibly teach a heated wire that may touch the skin is Iderosa. However, in Iderosa the wire is pre-heating the hair which must be at a low temperature. There is no teaching in the art of a wire heated to a temperature of at least 50°C which may touch the skin during operation. As stated above, the heated elements of Solvinto and Warden are not adapted to touch the skin. Similarly, Ringler shows heated element 11 which does not touch the skin under any circumstance.

Conclusion

In view of the above remarks, applicant submits that the finality of the office action should be revoked and that the claims are patentable over the prior art. Allowance of the application is respectfully awaited.

Respectfully submitted,



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Enclosures:

- Information Disclosure Statement (IDS)